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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,095	12/30/2003	Jason T. Petrin	59489US002	6935

32692 7590 01/04/2008

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EXAMINER	
NILAND, PATRICK DENNIS	
ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
01/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
LegalDocketing@mmm.com

Office Action Summary	Application No.	Applicant(s)	
	10/748,095	PETRIN ET AL.	
	Examiner	Art Unit	
	Patrick D. Niland	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/17/07*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication US 2003/0236340 Kubicek et al..

The terminal disclaimer for the related US Patent is noted. However, a terminal disclaimer is not effective in overcoming a rejection under this section of the statute. See MPEP 706.02(b) [R-5] Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent.

Kubicek discloses the instantly claimed invention at the abstract; sections [0004]-[0057]; and the remainder of the document clearly discloses the instantly claimed inventions.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed ingredients and amounts thereof in the inventions of Kubicek because they are encompassed by Kubicek and would have been expected to give the benefits described by Kubicek. Kubicek discloses the benefits of using pigment amounts above the critical PVC at section [0064] and the amount of pigment gives only predictable results such as predictable shade, color, hue, chroma, and surface character of the resulting film, with more particles contributing to a rougher film surface as expected from "flat paint" of section [0064].

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above and below. Firstly, the instant claims and the disclosure of the reference abut at the PVC though the percentage amounts overlap apparently. The PVC portion of the

claimed pigment amount appears to give only predictable results. See section [0064]-[0066] of the reference for example as well as the entirety of the reference. It is noted that the full disclosure of the reference requiring a PVC of at least 20% includes up to preferably 54%. It is noted that this is a preferred mode and is taken to include higher amounts of pigments. Such PVCs appear to be within those of the instant application examples such as those of Table 1 Examples 1-6.

See MPEP 2141: I. The KSR Decision and Principles of the Law of Obviousness

The Supreme Court in KSR reaffirmed the familiar framework for determining obviousness as set forth in Graham v. John Deere Co. (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. KSR, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should look only to the problem the patentee was trying to solve " (Id. at ___, 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (Id.); (3) by

concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try'" (Id.); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny factfinders recourse to common sense" (Id.).

In KSR, the Supreme Court particularly emphasized "the need for caution in granting a

patent based on the combination of elements found in the prior art,"Id. at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."Id. at ___, 82 USPQ2d at 1395. The use of an amount of pigment within the overall ranges of both the prior art and the instant claims and at or slightly above the critical PVC would appear to yield only predictable results to the ordinary skilled artisan. Furthermore, it is not seen that the critical PVC is a very rigidly defined point, mathematically speaking, that is not within the overall disclosure of the reference, as stated above, such as section [0066]. Thus, it appears that the closeness of the endpoints and potential overlap thereof between the instant claims and the cited prior art disclosure is such that the instantly claimed invention would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention. See MPEP 2144.05 II.

OPTIMIZATION OF RANGES

A. Optimization Within Prior Art Conditions or Through Routine Experimentation

Generally, differences in concentration or temperature will not support the patentability of

subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. Such criticality has not been shown in the instant case. Furthermore, the prior art range and the instantly claimed range touch, but do not overlap, at a mathematical point possibly. It is at least obvious to move over one mathematical point from the reference disclosure into the instantly claimed invention because such a move is within

experimental error in measuring and would be expected to give only predictable results from the endpoint of the reference disclosure of pigment amount. There are no unexpected results seen which are commensurate in scope with the prior art and the instant claims. This rejection is therefore maintained.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication US 2003/0236340 Kubicek et al..

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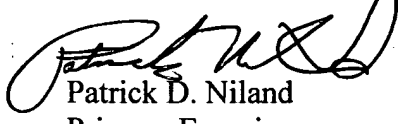
It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed ingredients and amounts thereof in the inventions of Kubicek because they are encompassed by Kubicek and would have been expected to give the benefits described by Kubicek.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714